

REMARKS/ARGUMENTS

The presently outstanding restrictions requirement of October 5, 2006, denominated five groups:

- I). Claims 1-8 and Claims 18-19, drawn to method for measuring IP₃ and a kit, classified in class 435, subclass 7.1.
- II). Claims 9, 12 and 18-19, drawn to method for measuring IP₃ using a homogenous format, classified in class 435, subclass 7.9.
- III). Claims 10, 11 and 13, drawn to a method for measuring IP₃, classified in class 435, subclass 7.8.
- IV). Claims 14, 15 and 20-21, drawn to method for measuring IP₃ and a kit, classified in class 435, subclass 7.91.
- V). Claims 16-17, drawn to compounds, classified in class 436, subclass 544.

In addition, the Restriction Requirement required a species election of a “detectable label” for Group I or a “compound” for Group IV. That is, paragraph 6 of the Restriction Requirement requires election of a “single species of ‘detectable label’....Fluorescer label and enzyme label are distinct for having different chemical structures and different chemical properties.”

Applicants provisionally elect Group I with traverse as to Groups II through IV. In addition, a typographical error has been corrected in claim 12, correcting the dependency of that claim to make it depend from claim 10, so that claim 12 should properly be included in Group III.

As the selected species, applicants elect the enzyme label, further defined in claim 9 as “an ED of from 37 to 60 amino acids derived from β-galactosidase joined through a linker at the 2-hydroxyl position.” The claims of Group I that are readable thereon are claims 2 – 6, 8, and 18-19.

Attorney Docket No. 3817.14-1
Customer No. 23308

Applicants reserve their rights under MPEP 821.04(a) to rejoinder of product and process claims, and to examination of generic claims, in the event the Restriction Requirement as written is made final.

It is submitted that the Examiner is only partially correct in the restriction requirement, and that method claims of Groups I – IV should be examined together. Each Group of I through IV is defined as a “method for measuring IP_3 .”

Applicants accept the Examiner’s position that the enzyme fragment label and the fluorescer label are patentably distinct. However, in searching the enzyme label in the context of the subject process, the Examiner would inherently include all other labels in order to decide whether a label other than a fluorescer would be a basis for a rejection based on obviousness. Therefore, it is submitted that all of the searching for all of the process claims will have been done in searching the literature for the subject species. Therefore, all of the work will be done in searching Group I. Even in the event that the subject species is found to be obvious, the search done by the Examiner will inherently include the fluorescent species.

Applicants are not aware of how one would search the subject process without encountering all of the possible labels. While it is theoretically possible to search only the labeled compound that would include significantly more art than searching the process that is being claimed without limiting as to the label. Even if one were to search as to the compound that is the species of the claimed process, one is likely to encounter the other species.

Furthermore, all of the claims share a nexus in being a process using a labeled IP_3 and a receptor for detecting IP_3 . As such, obviousness considerations will be common to the claims. While there are differences in the obviousness considerations, such as the use of a reductant, once the broader process claims are found to be allowable, then it must follow that the use of the reductant will also be allowable.

Attorney Docket No. 3817.14-1
Customer No. 23308

It is submitted that, as a matter of policy, this application is best considered as to all of the process claims simultaneously and that this would not involve a greater burden on the Examiner.

Conclusion

For all of the reasons given above, the Examiner is respectfully requested to withdraw the restriction requirement as to Groups I –IV. If the Examiner believes that the prosecution of this application can be expedited by a telephone conference, he is respectfully requested to call Bertram Rowland, Reg. no. 20,015 at 650 344 4674.

Respectfully submitted,

PETERS, VERNY, JONES,
SCHMITT & ASTON, LLP

Dated: 10/26/2006

By 

David J. Aston, Reg. No. 28,051
Tel.: (650) 324-1677
Fax: (650) 324-1678